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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 9

Application Number: 09/911,620

Filing Date: July 24, 2001

Appellant(s): MILLER, JUDITH F.

MAILED

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GROUP 3700

Guy D. Yale
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/05/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claim 20 depends from claim 15. Appellant's first group includes claims 1-5, 7, 8, 20 and 21; this grouping must include claim 15 for it to contain claim 20.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,681,587	Eberl et al	7-1987
3,161,200	Brickman	12-1964

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-20 rejected under 35 U.S.C. 102(b) as being anticipated by Eberl et al (4,681,587).

Referring to figure 3, Eberl et al teaches detachably coupling a "comfort" pad 3b to a breast prosthesis 1 utilizing hook-and-loop fasteners 7. The pad has a "shape generally congruent" to the first shape of the rear surface.

It is the Examiner's position that the "**pad member 3b**" of Eberl et al is considered a "**comfort pad**" because it reduces the weight of the prosthesis making it more comfortable for the wearer, is constructed of materials such as cotton which is well known for its breathability and softness for objects that are in contact with the skin, etc.

Claims 1-5, 7-8, 10-17, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brickman (3,161,200) in view of Eberl et al (4,681,587).

Brickman discloses a breast prosthesis 40, 80 having hook material 42, 44 (see figures 5-6) positioned on the front surface 46. The hook material is configured to engage loop material 76, 77 positioned in a bust cup 30 for releasable attachment. However, Brickman is silent in regards hook-and-loop fastener material on the rear surface of the breast prosthesis for attachment of a comfort pad.

Eberl et al teaches detachably coupling a "comfort" pad (3b and 4) to a breast prosthesis 1 utilizing hook-and-loop fasteners 7. It would have been obvious to one having ordinary skill in the art to have utilized the pad attached by hook-and-loop fasteners to the rear surface of the breast prosthesis as taught by Eberl et al with the prosthesis of Brickman to allow a substantially larger cavity reducing costs (see column 1, lines 32 et seq.) and further reducing the tendency to collapse. The hook and loop fasteners allow for easy removal for washing (see column 2, lines 1-2).

Referring to figure 3, some of the fasteners 7 are positioned along the periphery of the prosthesis.

Eberl et al teaches the fasteners are "strips" and therefore have a length greater than the width. Also, Brickman teaches length greater than width.

Eberl et al is silent whether the hook or loop portion of the fastener is attached to the rear of the prosthesis. It would have been an obvious reversal of parts to have either and would have been obvious to one having ordinary skill in the art. Note that Brickman teaches the hook portion position on the prosthesis.

Lacking any criticality in the specification, the use of substantially triangular shape with rounded corners the lacked elements in lieu of that used in the references solves no stated problems and is considered an obvious matter of design choice. Additionally, this shape is well known in the art and would have been obvious to one having ordinary skill in the art. See Becker et al (5,895,423) figure 1, "prior art" and new cited references.

(11) Response to Argument

Regarding appellant's section VIII – Rejection under 35 U.S.C. 102(b) as being anticipated by Eberl et al (4,681,587), the Examiner's position that "the "pad member 3b" of Eberl et al is considered a "comfort pad" because it reduces the weight of the prosthesis making it more comfortable for the wearer, is constructed of materials such as cotton which is well known for its breathability and softness for objects that are in contact with the skin, etc." is believed to be rational. This reasoning was taken directly from the specification of Eberl et al, see column 1, lines 10-64. Note that Eberl et al labels element 3b the "pad member". One of ordinary skill in the art understands that "a pad" is utilized to provide comfort. Further note that the pad inherently contacts the wear and becomes soiled and can be washed; see column 1, lines 65 et seq.

Appellant states the "citation of the Examiner to 3b as a "comfort pad" is clearly not the comfort pad of Applicant's claimed invention." Appellant provides drawings of their prosthesis and the prosthesis of Eberl et al for comparison. The Examiner notes that it is the claims that define the property rights and not the drawings.

Section IX, claims 1-5, 7-8, 10-17, 21-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Brickman (3,161,200) in view of Eberl et al (4,681,587).

Appellant argues that "the Examiner's position requires that one element be both the claimed prosthesis and the comfort pad which Applicant clearly teaches is to be a detachable backing for the prosthesis that can be easily removed and laundered" is not persuasive and appears to attaching the Brickman reference individually. Appellant is reminded that this is a combination rejection. Both Brickman and Eberl et al teach a

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breast prosthesis made of a material such as rubber. It would have been obvious to one having ordinary skill in the art to have utilized the pad attached by hook-and-loop fasteners to the rear surface of the breast prosthesis as taught by Eberl et al with the prosthesis of Brickman to allow a substantially larger cavity reducing costs (see column 1, lines 32 et seq.) and further reducing the tendency to collapse. The hook and loop fasteners allow for easy removal for washing (see column 2, lines 1-2).

Appellant further argues that the proposed combination does not disclose, teach, or suggest the hook material on the rear surface of the breast prosthesis. The Examiner's position copied from the grounds of rejection is believed rational: *Eberl et al is silent whether the hook or loop portion of the fastener is attached to the rear of the prosthesis. It would have been an obvious reversal of parts to have either and would have been obvious to one having ordinary skill in the art. Note that Brickman teaches the hook portion position on the prosthesis.*

Claims 10-14

The Examiner's position is believed to be adequately explained in the grounds of rejection wherein the combination rejection produces a prosthesis having hook material on a front surface and hook material on a rear surface.

Claims 15-16, Claims 17-18, Claims 22

These claims are directed to a breast prosthesis and comfort pad having generally or substantially triangular shape with rounded corners. The Examiner's position is that "*lacking any criticality in the specification, the use of substantially triangular shape with rounded corners in lieu of that used in the references solves no*

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stated problems and is considered an obvious matter of design choice. Additionally, this shape is well known in the art and would have been obvious to one having ordinary skill in the art. See Becker et al (5,895,423) figure 1, "prior art" and new cited references."

Applicant's arguments fail to show any criticality in the specification wherein the claimed shape provides any benefit or solves any problems over that taught by Eberl et al or Brickman. Secondly, additionally, as noted by the Examiner, the triangular shape with rounded corners is well known in the art and would have been obvious to use by one having ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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August 14, 2003

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